

## **REMARKS**

The application has been amended to distinguish the claimed invention over the cited prior art, and to place the application as a whole, into a *prima facie* condition for allowance at this time. Care has been taken to avoid the introduction of any new subject matter into the application as a result of the foregoing amendments.

Applicant has amended Claim 13 to address a typographical error. Specifically, Applicant has changed the word "adhesvie" to be "adhesive". Applicant respectfully submits that no new matter has been introduced as a result of this change.

Applicant has amended the first full paragraph on page 12, the second full paragraph on page 18, the second full paragraph on page 19, the second full paragraph on page 20, and the first full paragraph on page 22 to include appropriate text and reference numerals for fold lines 500, 502, 504, 506, and 508, respectively, in the backing panel. Support for such amendments to the specification is provided in the original disclosure in the first paragraph on page 12, in which it is disclosed that the recessed cell, upon articulation, will include openings on the sides of the recessed cell, as well as generally in Figs. 1-15. In addition, it would be readily apparent to one of ordinary skill in the art having the disclosure as originally filed before them for a fold line to exist at the noted locations because the recessed flap could not otherwise articulate to form a recessed cell.

Applicant has amended Figs. 1, 7, 9, 11, and 13 to include appropriate reference numerals to conform to the specification as amended. In addition, Applicant has amended Figs. 4, 5, and 12 to ensure consistency among the drawings with respect to the attachment of the articulated recessed cell along two edges. Applicant respectfully submits that no new matter has been introduced as a result of the foregoing amendments.

Applicant acknowledges with appreciation, the Examiner's indication that Claims 10-13, 16 and 17 would be allowable if rewritten in independent form to include the limitations of the base claim, and any intervening claims. In response thereto, Applicant has amended Claims 10 and 16 into independent form and respectfully submits that claims 10 and 16 are now in a *prima facie* condition for allowance at this time. Reconsideration and withdrawal of the objections to claims 10 and 16, and allowance thereof, are respectfully solicited.

Inasmuch as dependent Claims 11-13 and 17 merely serve to further define the subject matter of newly independent Claims 10 and 16, respectively, which claims themselves should now be deemed allowable, Claims 11-13 and 17 likewise should be deemed allowable.

Reconsideration and withdrawal of the rejections of Claims 11-13 and 17, and allowance thereof, are respectfully requested.

The Examiner has rejected Claims 1-9, 14, 15 and 22-28 under 35 U.S.C. §102(b) as being anticipated by Yoshiki et al (U.S. Pat. No. 4,957,202). Claims 18-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshiki et al (U.S. Pat. No. 4,957,202) in view of Brauner et al (U.S. Pat. No. 5,379,886). Applicant respectfully traverses the Examiner's substantive bases for rejection of the claims.

The Yoshiki et al. '202 reference discloses a carton, having inwardly foldable panels that create a recess or pocket for receiving an article, such as a premium. However, in this reference, the pocket is formed by one or more flaps, diecut from a first wall (e.g., a front wall), and a like number of corresponding flaps, of identical size, shape and arrangement, diecut from an adjacent contiguous wall (e.g., a side wall). The flaps of different sizes are used, to provide a recess that has a smaller "chamber" at one end, to accommodate a premium, such as a bottle, that has a decreased diameter or width at one end.

Applicant's invention, by contrast, includes, among other limitations, a patentably distinguishing and completely different recess forming structure, including, among other limitations:

at least one recessing flap formed in at least one of the front panel, back panel, two opposing side panels and top and bottom closures, said at least one recessing flap having a top edge, a bottom edge and two side edges,

- said at least one recessing flap being further formed from a depth-gauging panel, foldably emanating from an originating panel selected from one of the front panel, back panel, two opposing side panels, top closure and bottom closure along a selected edge of the top, bottom and two side edges of the recessing flap and a backing panel, foldably emanating from an interior edge of the depth-gauging panel disposed opposite from the selected edge of the at least one recessing flap to form a recessed cell in the carton which is at least partially separated from the interior region of the carton,

- at least one access panel disposed in, and foldably emanating from, one of the front panel, back panel, two opposing side panels, top closure and bottom closure, disposed adjacent to said originating panel, said at least one access panel foldably further foldably emanating from an opposite edge of the backing panel;

- the recessed cell spanning at least a portion of the originating panel and at least a portion of the at least one adjacent access panel to allow access to the recessed cell from outside the carton through at least two adjacent ones of said front panel, back panel, two opposing side panels, top closure and bottom closure.

The structure and mode of operation of the panels in the Yoshiki et al. reference places certain constraints on the shape and formation of the resulting recess. In order for the panels to be folded inwardly, without permanent creasing or other deformation, the panels must be arranged in identical pairs, which means that the cross-section of the recess is always square. This can result in a recess that does not conform optimally to the contours of the premium being contained. For example, a recess of square cross-section is not well-suited to a premium that is relatively thin and flat, compared to its length and width.

Applicant's invention of amended claim 1, addresses this structural constraint, by providing a total of three movable flaps or panels: the depth-gauging panel and the backing panel (which together form the at least one recessing flap), and the corresponding at least one access panel. The depth-gauging panel and the access panel act as levers or linkages, to permit the backing panel to swing inwardly (and laterally away from the wall from which the access panel is struck). Furthermore, by providing the combination of the depth-gauging panel and the access panel, the size and dimensions of the backing panel are not constrained to be the same as the panel in the adjacent wall, thus permitting the recess to have a non-square cross-section. One of ordinary skill in the art, having the disclosure before them, would readily note that the cross-section of the recess does not necessarily have to be rectangular (if the depth-gauging panel and the access panel were of different "height", for example).

There is simply no teaching or suggestion anywhere in the Yoshiki et al. '202 reference, of forming a recess in any other manner than by pairs of identically sized panels disposed in adjacent walls of the container, and certainly no teaching or suggestion of forming a recess through the use of three contiguous, foldably connected panels, as in Applicant's invention of amended claim 1.

Accordingly, Applicant respectfully submits that Yoshiki et al (U.S. Pat. No. 4,957,202) completely fails to teach or suggest Applicant's invention of amended Claim 1. Therefore, reconsideration and withdrawal of the rejection of Claim 1, under 35 U.S.C. §102(b) are respectfully solicited.

Applicant respectfully submits that the invention of amended claim 1 further distinguishes over the cited (but not yet substantively relied upon) Van Der Horst reference, U.S. 6,474,539. The Van Der Horst reference discloses a self-locking carton, having a recess formed in a closing lid of the carton. When the carton is closed, there remains only a single opening in the lid. While the reference may make casual mention of locating the opening in another wall of the carton, Applicant submits that there is no fair disclosure of providing for access from two adjacent sides of the carton which would serve to anticipate or obviate Applicant's invention of amended claim 1.

As such, Applicant submits that the invention of amended claim 1 patentably distinguishes over all of the prior art references of record. Reconsideration and allowance of amended claim 1 are respectfully solicited.

Inasmuch as dependent Claims 2-9, 14, 15, and 18-28 merely serve to further define the subject matter of amended independent Claim 1, which itself should be deemed allowable, reconsideration and withdrawal of the rejection of Claims 2-9, 14, 15, 18-28, and allowance thereof, are respectfully requested.

Applicant respectfully submits for the Examiner's consideration new Claims 29-34. Claims 29-34 comprise the subject matter of original Claims 10, 11, 12, 13, 16 and 17, which have been written to depend from amended Claim 1. Applicant respectfully submits that no new matter has been introduced as a result of adding these new claims. Inasmuch as new claims 29 - 34 merely serve to further define the subject matter of amended claim 1, which itself should be deemed allowable, consideration and allowance of new claims 29 - 34 are respectfully solicited.

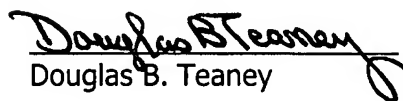
Applicant respectfully submits that through the addition of new claims 29 - 34, and the cancellation of original claims 3 and 4, that there is now a total of 4 claims more than were in the originally filed application. Applicant hereby expressly authorizes that the extra claim fee of \$72.00 (4 claims x \$18 per claim - large entity) be charged to Applicant's attorneys' deposit account no. 502428.

Applicant respectfully submits that the application as a whole, including all of Claims 1-2, and 4-34, is now in a *prima facie* condition for allowance at this time. Reconsideration and allowance of the application are respectfully requested.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully requested.

Respectfully submitted,  
GREENBERG TRAURIG

Dated: December 15, 2003

  
Douglas B. Teaney